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23368 7590 12/22/2009 DINSMORE & SHOHL LLP FIFTH THIRD CENTER, ONE SOUTH MAIN STREET SUITE 1300 DAYTON, OH 45402-2023			EXAMINER ROSS, DANA	
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRYAN W. VIDLER, FRANK LOMBARDO,
BRYCE C. WAGGONER, and GARY M. CAIRNS

Appeal 2009-004687
Application 10/822,386
Technology Center 3700

Decided: December 22, 2009

Before WILLIAM F. PATE III, STEVEN D.A. MCCARTHY, and
STEFAN STAICOVICI, *Administrative Patent Judges*.

WILLIAM F. PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

This is an appeal from the final rejection of claims 1, 2, 4, 6, 13, and 15. Claims 3, 5, 7-12, and 14 stand withdrawn from consideration. These are all the claims in the application. We have jurisdiction under 35 U.S.C. §§ 134 and 6.

The claimed subject matter is directed to a data carrier that provides health related information regarding a medical patient. The data carrier is characterized by a masking label formed integral with the data carrier so that the masking label can be removed and placed in a data obscuring relationship with the health information on the label.

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A data carrier for providing health related information regarding a patient, and for obscuring the association between the identity of the patient and the health related information when the data carrier is to be discarded, comprising:

a release liner,

a health information label having an upper surface and a lower surface, said label including a first area on said upper surface for indicia specifying health related information and a second area on said upper surface for indicia specifying the identity of a patient,

a pressure sensitive adhesive coating on said lower surface of said health information label, securing said health information label to said release liner, and

a masking label integral with said health information label, and

a die cut in said release liner defining a removable liner piece beneath said masking label, said removable liner piece being removable from said release liner with said health information label and remaining thereon when said health information label is applied to a surface, said removable liner piece permitting the removal of said masking label from said health information label so that said masking label can be applied over one or both of said first and second areas to

obscure the association between the identity of the patient and said health related information when the data carrier is to be discarded.

REFERENCES

The references of record relied upon by the Examiner as evidence of obviousness are:

Stone	US 4,549,750	Oct. 29, 1985
Blank	US 7,048,308 B2	May 23, 2006

REJECTIONS

Claims 1-2, 4, 13, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Blank.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Blank in view of Stone.

ISSUE

The Appellants and the Examiner have recognized the applicability of the so-called printed matter doctrine to the rejections on appeal. As such, the critical question on appeal is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. *See In re Gulack*, 703 F.2d 1381, 1384 (Fed. Cir. 1983). In the event that the printed matter is not functionally related to the substrate, the printed matter may not be entitled to patentable weight in evaluating the claimed subject matter under § 102 or § 103. *See In re Nagai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004.) Thus, the Appellants and the Examiner differ as to whether the printed matter claimed as “health information” in the independent claims on appeal is or is not functionally related to the data

carrier substrate. Therefore, the issue for our consideration is whether the “health information” including an area having indicia for specifying health related information is functionally related to the data carrier upon which the information appears.

Appellants do not provide separate arguments for the patentability of claim 6 beyond the arguments provided for independent claim 1. Accordingly, claims 6 will stand or fall with claim 1. See 37 C.F.R. § 41.37(c)(1)(vii).

ANALYSIS

We have carefully reviewed the arguments of the Appellants and the Examiner. On page 7 of the Answer, the Examiner states that the sole difference between Blank and the claimed subject matter relates to the arrangement and content of the printed matter. However, the claimed subject matter has a different and additional function in that by the placement of the indicia in the first and second areas and the provision of the die cut, the data carrier can be both a label of health care information and a cover or screen which eclipses or obscures such health care information. Therefore, with respect to the claims which are directed to a masking label that can be moved from one position on the data carrier to another position on the same data carrier, these claims, as noted above, are claims in which a functional relationship exists between the printed matter and the data carrier as the substrate. This additional function is by way of providing a self-carried, movable cover for the purpose of health information obscuration. Therefore, with respect to claims 1, 2, 4, and 6, we have found a functional relationship between the printed matter and the substrate which must be

given weight in an obvious rejection of these claims. Since the Examiner has not accorded this limitation due weight, the rejection of these claims under § 103 cannot be sustained.

On the other hand, with respect to claims 13 and 15, the second label claimed in these claims does not have a functional relationship beyond the removable label carrying health information shown in the Blank reference. In both the reference and the claimed subject matter, a printed matter portion of the label is merely removed from the label and discarded or otherwise secured. Blank specifically discloses that label tab 32 is configured to be removable from main label 14, hence teaching that the confidential information 30 (patient identity information) on label tab 32 is disassociated from the pharmacy and quantity information (health related information) on main label 14. *See* Blank, col. 3, ll. 4-8 and fig. 3. Thus, for claims 13 and 15 we do not find an additional functional relationship of any printed matter to a substrate beyond that disclosed in Blank. Therefore, the Examiner's § 103 rejection of claims 13 and 15 is sustained.

CONCLUSION

Appellants have established that the Examiner erred in rejecting claims 1, 2, 4, and 6 under § 103. The rejections of these claims are reversed.

The Appellants have not established that the Examiner erred in rejecting claims 13 and 15. The rejection of claims 13 and 15 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

Vsh

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